

**REMARKS**

Claim 10 has been objected to, and the foregoing amendment is believed to have corrected the objectionable subject matter. Accordingly, the objection should be withdrawn.

Claims 1-3 were rejected under 35 U.S.C. §103(a), as rendered obvious and unpatentable, over Webb in view of Vasile. Claims 4, 7 and 9 were rejected under 35 U.S.C. §103(a), as rendered obvious and unpatentable, over Webb in view of Vasile and in further view of Hurt. Claims 5 and 6 were rejected under 35 U.S.C. §103(a), as rendered obvious and unpatentable, over Webb in view of Vasile and in further view of Dawson. Claim 8 was rejected under 35 U.S.C. §103(a), as rendered obvious and unpatentable, over Webb in view of Vasile in further view of Larson. Claims 10 and 16-18 were rejected under 35 U.S.C. §103(a), as rendered obvious and unpatentable, over Vasile in view of Dawson. Claims 11-15, 19 and 20 were rejected under 35 U.S.C. §103(a), as rendered obvious and unpatentable, over Vasile and Dawson and in further view of Webb.

Independent claims 1, 10 and 18 have been amended to include features directed towards the laser generator, the pencil sharpener and the path of the laser beam generated by the laser generator. These features were originally found in now canceled claims 5, 6, 13, 14 and 19. In view of the foregoing amendments and claim cancellations, the above cited rejections are deemed moot.

The art applied against the claimed invention included Vasile, Webb and Dawson in various

combinations. Dawson was cited as a teaching of a multi-tool using a *pencil sharpener*. Webb was cited as a teaching of a multi-tool using a *laser generator*.

The Examiner fails to provide any teaching of a multi-tool including both a pencil sharpener and a laser generator. Without such a teaching, the Examiner errs in suggesting that one of ordinary skill in the art would have been motivated to include a laser generator and a pencil sharpener on the same multi-tool such that the combination would result in the projection of a laser beam by the laser generator through the pencil sharpener.

The Examiner implies that such a combination could be made "since pencil sharpeners allow light to pass along their axis."

The Examiner provides no reference teaching that pencil sharpeners will allow light to pass along their axis. Instead, the Examiner relies on the Applicant's teaching in a hindsight rejection.

Such suggestion by the examiner is clearly untenable and has no basis of factual support. Further, such a statement clearly relies on the disclosure of the applicant's invention and not on what the artisan would have gleaned only from the applied prior art. Therefore, the examiner improperly uses hindsight of the applicant's invention as a teaching in support of the rejection. *In re Warner*, 745 F.2d 1341, 166 USPQ 406, 407 ftnt. 3 (CCPA 1970), *In re Horn*, 203 USPQ 969 (CCPA 1979).

*In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)

One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Even though some hindsight may be necessary in making a §103 rejection, *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971), the examiner has improperly used a teaching supplied only by the applicant with regard to the projection path of the laser beam. The test for obviousness is what the combined teachings of the references would have suggested to the artisan. *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Note that *McLaughlin* qualifies the statement that some hindsight may be necessary by inclusion of "...and does not include knowledge gleaned only from applicant's disclosure".

Additionally, that a prior art device could be modified to produce the claimed device does not justify an obviousness rejection unless the prior art suggested the modification's desirability. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). There has been no suggestion by the applied art teaching it would be desirable to project the laser beam through a pencil sharpener.

Accordingly, claims 1, 2, 4, 7-12, 15-18 and 20 are deemed to be allowable over the art of record, since there is no teaching of a multi-tool using both a laser generator and a pencil sharpener in combination such that a laser beam generated by the laser generator projects through the pencil sharpener.

The examiner is respectfully requested to reconsider the application, withdraw the objections and/or rejections and pass the application to issue in view of the above amendments and/or remarks.

Should a Petition for extension of time be required with the filing of this Amendment, the

Commissioner is kindly requested to treat this paragraph as such a request and is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of the incurred fee if, **and only if**, a petition for extension of time be required **and** a check of the requisite amount is not enclosed.

Respectfully submitted,

  
\_\_\_\_\_  
Robert E. Bushnell  
Attorney for Applicant  
Reg. No.: 27,774

1522 K Street, N.W.  
Washington, D.C. 20005  
(202) 408-9040

Folio: P57011  
Date: 2/18/05  
I.D.: REB/MDP